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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,306	09/30/2003	Joseph P. Bigus	YOR920030270US1	4089
29154	7590	06/19/2008		
FREDERICK W. GIBB, III Gibb & Rahman, LLC 2568-A RIVA ROAD SUITE 304 ANNAPOLIS, MD 21401			EXAMINER LASTRA, DANIEL	
			ART UNIT 3688	PAPER NUMBER
			MAIL DATE 06/19/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/674,306	Applicant(s) BIGUS ET AL.	
	Examiner DANIEL LASTRA	Art Unit 3688	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 20-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 20-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1 and 22-36 have been examined. Application 10/674,306 (METHOD FOR COMPUTING PRICE DISCOUNTS IN AN E-COMMERCE ENVIRONMENT) has a filing date 09/30/2003.

Claim Objections

2. Claims 20 and 21 are objected because said claims are dependent of previously cancel claims. Accordingly, said claims have not been further treated on the merits as said claims' limitations are already recited in claim 1.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 1 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent, a method/process claim must (1) be tied to another statutory class of invention (such as a particular apparatus) (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)). A method/process claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here the claims fails to meet the above requirements because the steps are neither tied to another statutory

class of invention (such as a particular apparatus). For example, claim 1 recites "computing valid combination" but does not recite in what apparatus said computing is performed.

Specification

4. Any computer program listing may, and any computer program listing having over 300 lines (up to 72 characters per line) must, be submitted on a compact disc in compliance with § 1.52(e). A compact disc containing such a computer program listing is to be referred to as a "computer program listing appendix." The "computer program listing appendix" will not be part of the printed patent. The specification must include a reference to the "computer program listing appendix" at the location indicated in § 1.77(b)(5) See MPEP 37s 1.95.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 25 recites the limitation "said price discount rule". There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 22-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz (US 2001/0014868).

Claim 1, Herz teaches:

A method of computing price discounts for an electronic commerce order, said method comprising:

categorizing applicable price discounts for an individual customer order (see paragraph 73);

computing valid combinations of price discounts for said individual customer order (see paragraph 73);

combining said valid combinations of price discounts into a price discount group (see paragraph 247;

selecting an optimal price discount based on said price discount group: wherein said individual customer order comprises at least one order line item, wherein said at least one order line item comprises a unique item identifier, a quantity ordered identifier, and a price per unit identifier for each item being ordered (see paragraph 240),

wherein said unique item identifier comprises a stock keeping unit (SKU) identifier (see paragraph 263), wherein said applicable price discounts are based on a customer's identity, date of order, identities of individual items purchased, combinations of items purchased, quantity of items purchased, and total price of items purchased, wherein said price discounts comprise a fixed percentage off price discount, a fixed

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dollar amount off price discount, a free merchandise rebate price discount, and a combination discount thereof (see paragraphs 247-248), and

wherein a discount object command is created when said price discount group is selected, wherein said discount object command binds said price discounts to a respective item in said order (see paragraph 248).

Claim 22, Herz teaches:

A system for computing price discounts for an electronic commerce order comprising:

a first unit operable for categorizing applicable price discounts for an individual customer order (see paragraph 73);

a computer configured to said first unit and operable for computing valid combinations of price discounts for said individual customer order (see paragraph 73);

a component configured to said computer and operable for combining said valid combinations of price discounts into a price discount group (see paragraph 247);

a processing control mechanism configured to said component and operable for processing subsets of price discount rules within said price discount group; and a second unit configured to said component and operable for selecting an optimal price discount based on said price discount group (see paragraphs 247-248).

Claim 23, Herz teaches:

a sequence of commands input into said computer, wherein said commands bind price discount information to a respective item in said electronic commerce order (see paragraphs 247-248).

Claim 24, Herz teaches:

a disabling mechanism configured to said computer and operable for preventing gratuitous discounts from being applied to said electronic commerce order (see paragraph 267).

Claim 25, Herz teaches:

a priority controller mechanism configured to said computer and operable for prioritizing a sequential order of evaluating said price discount rules (see paragraphs 247-248).

Claim 26, Herz teaches:

wherein said individual customer order comprises at least one order line item, wherein said at least one order line item comprises a unique item identifier, a quantity ordered identifier, and a price per unit identifier for each item being ordered, and wherein said unique item identifier comprises a stock keeping unit (SKU) identifier (see paragraph 240).

Claim 27, Herz teaches:

wherein said applicable price discounts are based on a customer's identity, date of order, identities of individual items purchased, combinations of items purchased, quantity of items purchased, and total price of items purchased (see paragraph 240).

Claim 28, Herz teaches:

wherein said price discounts comprise a fixed percentage off price discount, a fixed dollar amount off price discount, a free merchandise rebate price discount, and a combination discount thereof (see paragraph 72).

Claim 29, Herz teaches:

wherein a discount object command is created when said price discount group is selected, wherein said discount object command binds said price discounts to a respective item in said order (see paragraph 72).

Claim 30, Herz teaches:

A program storage device readable by computer, tangibly embodying a program of instructions executable by said computer to perform a method of computing price discounts for an electronic commerce order, said method comprising:

categorizing applicable price discounts for an individual customer order; computing valid combinations of price discounts for said individual customer order; combining said valid combinations of price discounts into a price discount group; and selecting an optimal price discount based on said price discount group (see paragraphs 72 and 247-248).

Claim 31, Herz teaches:

wherein said individual customer order comprises at least one order line item (see paragraph 267).

Claim 32, Herz teaches:

wherein said at least one order line item comprises a unique item identifier, a quantity ordered identifier, and a price per unit identifier for each item being ordered (see paragraph 267).

Claim 33, Herz teaches:

wherein said unique item identifier comprises a stock keeping unit (SKU) identifier (see paragraph 263).

Claim 34, Herz teaches:

wherein said applicable price discounts are based on a customer's identity, date of order, identities of individual items purchased, combinations of items purchased, quantity of items purchased, and total price of items purchased (see paragraphs 247-248).

Claim 35, Herz teaches:

wherein said price discounts comprise a fixed percentage off price discount, a fixed dollar amount off price discount, a free merchandise rebate price discount, and a combination discount thereof (see paragraph 72).

Claim 36, Herz teaches:

wherein a discount object command is created when said price discount group is selected, wherein said discount object command binds said price discounts to a respective item in said order (see paragraph 72).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 571-272-6720 and fax 571-273-6720. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W. STAMBER can be reached on 571-272-6724. The official Fax number is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/DANIEL LASTRA/

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June 17, 2008